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Supreme Court of the United States

OCTOBER TERM, 1942.

No. 409

UNITED STATES GAUGE COMPANY, *Petitioner,*

v.

PENN ELECTRIC SWITCH COMPANY, *Respondent.*

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI.

May it please the Court:

The petition of the United States Gauge Company shows to this Honorable Court:

A.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Respondent brought this declaratory judgment suit (R. 2) against petitioner, a Pennsylvania corporation, in the District Court of the United States for the Northern District of Illinois, Eastern Division. The suit sought a decree that claim 5 of petitioner's patent was void and had not been infringed by respondent. Petitioner challenged the venue of

the action by a timely motion. (R. 10) The motion was denied. (R. 21)

Petitioner then answered and counterclaimed for infringement of said patent. (R. 22) The case was tried on its merits in due course. The District Court held that respondent had infringed said patent, if valid; but ruled that the claim of the patent in suit was void for lack of invention. (R. 282)

Petitioner submitted certain proposed findings of fact at the conclusion of the trial. (R. 297, 298, 299) The District Court refused to adopt said findings (R. 301) though many of them related to matters, which, under the great weight of authority, were evidence that the exercise of the inventive faculty was required to produce the patented device.

Petitioner appealed to the Circuit Court of Appeals and, among other things, urged error by the District Court in its ruling on petitioner's attack on the venue of the action; and in the refusal of that Court to make the findings of fact proposed by petitioner and asserted to evidence invention. (R. 308) The Circuit Court of Appeals affirmed the ruling of the District Court on the venue point, and held that "evidence of inventive genius" was not manifest in the work of the inventor, who had assigned his rights to petitioner. (R. 501)

B.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

Point 1. The Circuit Court of Appeals made a finding that petitioner has "a regular and established place of business" in Chicago. (R. 503) This shows that the Court regarded the Act of Congress, March 3, 1897, c. 395, 29 Stat. 695; March 3, 1911, c. 231, § 48, 36 Stat. 1100 (28 U. S. C. Sec. 109),* in which this language appears, as the statute determining the venue of a declaratory judgment suit concerning the scope and validity of a patent. The weight of

* Printed in appendix.

previous authority was that the general venue statute, Sec. 51, R. S. § 739; Act of Congress March 3, 1875, c. 137, § 1, 18 Stat. 470; March 3, 1887, c. 373, § 1, 24 Stat. 552; Aug. 13, 1888, c. 866, § 1, 25 Stat. 433; Mar. 3, 1911, c. 231, § 51, 36 Stat. 1101; Sept. 19, 1922, c. 345, 42 Stat. 849; March 4, 1925, c. 526, § 1, 43 Stat. 1264; April 16, 1936, c. 230, 49 Stat. 1213 (28 U. S. C. Sec. 112),* controls such cases. The same Court had previously so ruled in several cases. The point has never been passed on by this Court. The ruling in this case makes the law unsettled on an important question of federal law.

Point 2. The Circuit Court of Appeals held that, on the facts shown in this case, petitioner was subject to service of process in Illinois, the circumstance that petitioner was licensed to do business there being adverted to in this connection. (R. 503) It is presumed that the Court was of the view that petitioner had waived its right to object to venue under the authority of *Neirbo Company et al.* v. *Bethlehem Shipbuilding Corporation, Ltd.*, 308 U. S. 165. The District Court expressly so held, (R. 21) supporting respondent's contention to this effect and overruling petitioner in its assertion that the doctrine of said authority applied only to cases involving subject matter of which the Federal and State Courts have concurrent jurisdiction, that is, to cases in which the jurisdiction of the Federal Court depended only upon diversity of citizenship. Certain it is that jurisdiction in *Neirbo Company et al.* v. *Bethlehem Shipbuilding Corporation* arose because of the diversity of citizenship of the litigants. This is not such a case. The scope or extent of the waiver arising by compliance of a corporation with a State law requiring registration, as a prerequisite to doing business in said State, is unsettled, unless the decision in this case, which does not clearly discuss the matter, and does not refer to said authority, can be said to settle the law on this important point. Moreover, the law is further unsettled by the decision of the Circuit Court of Appeals for the

* Printed in appendix.

Seventh Circuit in *Heine Chimney Company* v. *Rust Engineering Company*, 12 F. (2d) 596, that registration under a State law does *not* amount to a waiver of the right to object to venue in a patent infringement suit in which Section 48 determines venue. To the same effect is *Endrezze* v. *The Dorr Company, Inc.*, 97 F. (2d) 46 (C. C. A. 9).

Point 3. So far as petitioner knows, there is no definition in the patent laws, or in the many decisions interpreting said laws, of what constitutes "invention". Yet it is clearly recognized that no art, machine, manufacture, or composition of matter, however novel, is patentable unless invention was required to discover or devise it. In the absence of a definition of "invention", the Courts have noticed certain criteria, symptoms or indicia and have held them to evidence "invention", such as (1) the existence of a prior long-felt and unsupplied want for the patented invention; (2) unsuccessful attempts to fulfill said want over a long period of time; (3) recognition by the art of the merit of the invention by widespread adoption of the invention when available; (4) subsequent extension of the use of the invention by manufacturers generally throughout the United States; (5) adoption on a national scale because of the merit of the patented invention, rather than because of extensive advertising; and (6) acquiescence of the validity of the patent by respect therefor by the trade concerned generally. The existence of these criteria, symptoms or indicia of invention are submitted to have been proven in this case. (R. 297, 298, 299) Yet, it was held that the patent in suit was void for lack of invention. (R. 282, 506) It has never been expressly ruled that said evidences of invention, when established, rather than the hindsight view of the Court, should determine any issue of invention in favor of the patent, though petitioner submits that the great weight of authority implies that such is the rule. In ruling that the patent in suit lacked "invention", under the facts of this case the Court departed from the accepted and usual course of judicial procedure to such extent as to call for an exercise of this Court's power of supervision.

WHEREFORE, Your Petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the Circuit Court of Appeals for the Seventn Circuit, commanding that Court to certify and to send to this Court for its review and determination a full and complete transcript of the record and all proceedings in the case numbered and entitled on its Docket No. 7872, *Penn Electric Switch Company, Plaintiff-Appellee,* versus *United States Gauge Company, Defendant-Appellant,* and that the said decree of the Circuit Court of Appeals for the Seventh Circuit may be reversed by this Honorable Court, and that your Petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

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